

REMARKS

Following entry of the foregoing amendments, claims 120, 121, 124 to 128, 131 to 133, 136 to 154, and 157 to 167 will be pending in this patent application. Claims 125, 126, 128, 131 to 133, 141, 142, 144 to 147, 150 to 154, and 157 to 167 have been withdrawn from consideration as drawn to non-elected subject matter. Claim 120 has been amended, and claims 122, 123, 129, 130, 134, 135, 155, and 156 have been canceled, herein, without prejudice. Support for the amendments to claim 120 is found throughout the specification as originally filed, as discussed more fully below, and the amendments thus do not introduce new matter into the application.

Applicants respectfully request reconsideration of the rejections of record in view of the foregoing amendments and the following remarks.

Priority

The present application is a continuation in part of application number 10/078,949, which is a continuation of application number 09/479,783, which is a divisional of application number 08/870,608, filed June 6, 1997. Support for the presently claimed subject matter exists in application number 08/870,608 and in each of the subsequent applications in the priority chain for the present application. The Office asserts, however, that the applications to which the present application claims priority do not provide adequate support for subject matter recited in the pending claims. Specifically, the Office asserts that support does not exist in the priority applications for compositions comprising first and second chemically synthesized oligomeric compounds in which at least 17 contiguous nucleobases of the first oligomeric compound are 100% complementary to at least 17 contiguous nucleobases of the second oligomeric compound.¹ This subject matter is, however, adequately supported by the specification of the 608 application, and the claims are thus entitled to the benefit of the filing date of the 608 application.

As noted by the Office,² Example 25 of the 949 application, which is also present in the 608 and present applications, describes a duplex comprising two oligonucleotides, each of which

¹ Office action dated January 9, 2008, pages 2 to 3.

² *Id.* at 3.

is 17 nucleosides in length, and one strand of which is a gapmer. In addition, Example 27, which also appears in the specifications of the 608, 949, and present application, describes duplexes used as substrates for double-strand RNases in which both strands are gapmers. The Office asserts that the description provided in these examples does not support the claimed recitation of “at least 17 contiguous nucleobases of 100% complementarity,” however. Without acquiescing in the correctness of this assertion, and to advance prosecution, the claims have been amended herein to no longer recite “at least 17 nucleobases of 100% complementarity,” obviating the basis for the denial of the claim for priority. The present claims are fully supported by the 608 application, and applicants respectfully ask the Office to accord the claimed subject matter the benefit of the filing date of the 608 application, which is June 6, 1997.

Claim Objections

Claim 122 has been objected to. Without acquiescing in the objection, and to advance prosecution, claim 122 has been canceled without prejudice, obviating the objection.

Alleged Lack of Written Description

Claims 120 to 124, 127, and 136 to 138 have been rejected under 35 U.S.C. § 112 first paragraph as allegedly failing to comply with the written description requirement. The Office asserts that the specification fails adequately describe compositions comprising first and second chemically synthesized oligomeric compounds in which at least 17 contiguous nucleobases of the first oligomeric compound are 100% complementary to at least 17 contiguous nucleobases of the second oligomeric compound. As discussed above, without acquiescing in the correctness of this assertion, and to advance prosecution, claim 120 has been amended to no longer recite “at least 17 nucleobases of 100% complementarity,” obviating the rejection. Applicants accordingly, respectfully, request withdrawal thereof.

Alleged Anticipation

Claims 120, 121, 123, 124, 127, and 136 to 138 have been rejected as allegedly anticipated by U.S. patent number 6,107,094 (“the Crooke patent”), which is the patent that issued from the 608 application, discussed above. Since the present application is entitled to the

benefit of the filing date of the 608 application, the Crooke patent is not prior art with respect to the present application. Applicants accordingly, respectfully, request withdrawal of the rejection.

Alleged Obviousness

Claims 120 to 124, 127, and 136 to 138 have been rejected as allegedly rendered obvious by the Crooke patent in view of Elbashir, *EMBO J.*, 2001, 20, 6877-6888 ("the Elbashir article"). As discussed above, the Crooke patent is not prior art with respect to the present application. Similarly, the Elbashir article was published in 2001, well after the filing date of the 608 application, to which the present application claims priority, as discussed above. The Elbashir article is thus also not prior art with respect to the present application, and applicants accordingly, respectfully, request withdrawal of the rejection.

Alleged Double Patenting

Claims 139, 140, 143, 148, and 149 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 4, 7, and 8 of U.S. patent number 6,107,094 and over claim 29 of U.S. patent number 5,898,031. Applicants request deferral of these rejections pending the identification of allowable subject matter in the present application, as the rejections can likely be readily resolved, depending upon the subject matter ultimately allowed, through the filing of suitable terminal disclaimers.

Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the official action of record. Accordingly, an early and favorable action is respectfully requested.

Respectfully submitted,

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